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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/853,033      | 05/11/2001  | Pierre Chambon       | 065691-0222         | 5081             |

7590

12/31/2002

Stephen B. Maebius  
FOLEY & LARDNER  
Suite 500  
3000 K Street, N.W.  
Washington, DC 20007-5109

EXAMINER

QIAN, CELINE X

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/853,033

Applicant(s)

CHAMBON ET AL.

Examiner

Celine X Qian

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 9, 16, 17, 25-32, 35-39 and 53-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8, 10-15, 18-24, 33, 34, 40-52 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

Claims 1-61 are pending in the application.

***Election/Restrictions***

Applicant's election of Group I in Paper No. 10 (claims 1-8, 10-15, 18, 20, 33, 40-52) is acknowledged. Applicants indicate that claims 19, 21-24 and 34 were not restricted into a particular group. Applicants further assert that these claims embrace the invention of Group I and should be examined with Group I. Upon further review of the claims, it was found that the examiner inadvertently overlooked the requirement to separate transgenic metazoan organisms having different genotype into different groups in the earlier office action. Therefore, further restriction is required. Claims 19, 21-24 and 34 will be considered together with claims of Group I in this restriction requirement. The office apologizes for the inconvenience that is caused by this mistake.

Claims 1-8, 10-15, 18-24, 33, 34 and 40-52 are restricted into following Groups.

- Group i. Claims 13, 21, 40, 52, drawn to a transgenic metazoan organism comprising K5-Cre-ER<sup>T</sup>/RXR $\alpha$ <sup>L2/L2</sup> genotype, classified in class 800, subclass 18.
- Group ii. Claims 14, 21, 41, 52, drawn to a transgenic metazoan organism comprising K5-Cre-ER<sup>T2</sup>/RXR $\alpha$ <sup>L2/L2</sup> genotype, classified in class 800, subclass 18.
- Group iii. Claims 15, 21, 42, 52, drawn to a transgenic metazoan organism comprising K5-Cre-ER<sup>T3</sup>/RXR $\alpha$ <sup>L2/L2</sup> genotype, classified in class 800, subclass 18.

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Group xi. Claims 14, 23, 50, 52, drawn to a transgenic metazoan organism comprising aP2-Cre- ER<sup>T2</sup>/RXR $\alpha$ <sup>L2/L2</sup> genotype, classified in class 800, subclass 18.

Group xii. Claims 15, 23, 51, 52, drawn to a transgenic metazoan organism comprising aP2-Cre- ER<sup>T3</sup>/RXR $\alpha$ <sup>L2/L2</sup> genotype, classified in class 800, subclass 18.

Claims 1-8, 10-12, 19, 20, 33 and 34 link(s) inventions of Group I-xii. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-8, 10-12, 19, 20, 33 and 34. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Applicants are further required to pick one element from claims 2, 4, 5 and 19.

The inventions are patentably distinct, each from the other for following reasons:

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The invention of Group i-xii are patentably distinct from each other because the inventions are drawn to compositions that are materially different. The transgenic metazoan organism of Groups i-xii comprising different genetic materials in its genome. As such, the transgenic organism of Groups i-xii are chemically, biologically and functionally distinct from each other. Therefore, the inventions of Groups i-xii are patentably distinct from each other.

Claims 2, 4, 5 and 19 each recites different elements (genes or recombinant sites) such that the result transgenic metazoan organism is chemically, biologically and functionally distinct, each from the other. Therefore, election of only one of these elements is required.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. A search of the subject matter of one invention would not be co-extensive with a search of the other invention. A search of all 12 groups in a single application would be burdensome.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X Qian whose telephone number is 703-306-0283. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Celine Qian, Ph.D.  
December 23, 2002

  
TERRY MCKELVEY  
PRIMARY EXAMINER



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Remarks:

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